

REMARKS

In the prior Office Action, the Examiner allowed claims 11-15, objected to claims 6-9 and rejected claims 1-5, 10 and 16-38. In view of the allowable subject matter, Applicants chose to amend the prior application to place it in condition for allowance. The present Response addresses the Examiner's rejections. Claims 1, 3, 5, 10 and 16 of the continuation application have been amended to set forth the subject matter of the invention more clearly. Claims 2 and 11-15 have been cancelled. Consideration of the continuation application as amended is respectfully requested.

Objections to the claims

The Examiner objected to claim 16 and indicated that “‘sub-’ should be ‘sub-system.’” Applicants have amended claim 16 to recite a “sub-system.” Applicants respectfully submit that the amendment is sufficient to overcome the Examiner's objection.

Rejections under 35 U.S.C. § 112

The Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated:

It is not known if the further definition of act (a) is a partial or complete replacement of claim 3's definition of act (a) since the sequentially enabling portion is not included in claim 5. For the purpose of examination the examiner will interpret claim 5's definition of act (a) to completely replace claim 3's definition of act (a) making it appropriate for claim 5 to be dependent upon claim 2.

Applicants have amended claim 5 to be dependent upon claim 1. Applicants respectfully submit that claim amended 5 complies with 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 102

The Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Santeler et al. (U.S. Pat. No. 6,223,301). Applicants respectfully traverse this rejection.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

Claim 1 has been amended to include the limitations of dependent claim 2. As stated by the Examiner in his rejection of claim 2 under 35 U.S.C. § 103(a), the Santeler et al. reference “does not disclose the segment of semiconductor memory comprises a memory cartridge.” With claim 1 amended to include this limitation, it should be evident that claim 1 as amended cannot possibly be anticipated by Santeler et al. since claim 1 clearly recites elements not found in the cited reference. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejection under 35 U.S.C. § 102(e).

Rejections under 35 U.S.C. § 103

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Santeler et al. (U.S. Pat. No. 6,223,301). The Examiner rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Santeler et al., in view of Bellamy (U.S. Pat No. 5,268,592). The Examiner rejected claims 5 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Santeler et al., in view of Olarig et al. (U.S. Pat. No. 6,098,132). The Examiner rejected claims 16-19, 25-30, 32, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Olarig et al., in view of Santeler et al. The Examiner rejected claims 20-24 under 35 U.S.C. § 103(a) as being unpatentable over Olarig et al., in view of Santeler et al., and in further view of Windsor et al. (E.P. 398,188). The Examiner rejected claims 28 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Olarig et al., in view of Santeler et al., and in further view of Liencres et al. (J.P. 9,222,940). The Examiner rejected claims 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Olarig et al., in view of Santeler et al., and in further view of Bailis et al. (U.S. Pat. No. 6,434,652). Finally, the Examiner rejected claims 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Olarig et al., in view of Santeler et al., and in further view of Rasums et al. (U.S. Pat. No. 5,572,395).

Applicants respectfully submit that neither the Olarig et al. reference nor the Santeler et al. reference qualifies as prior art against the above-referenced application under 35 U.S.C. § 103. In accordance with 35 U.S.C. § 103(c) and Pub.L. 106-113, § 4807 enacted November 29, 1999, subject developed by another person which qualifies as prior art only under subsection (e) of 35 U.S.C. § 102, shall not preclude patentability where the subject matter

and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Here, both the Olarig et al. reference and the claimed invention were, at the time the invention was made, owned by the present assignee (Compaq Computer Corporation) or subject to an obligation of assignment to the present assignee. Since the present application was filed after November 29, 1999 and since the Olarig et al. reference did not issue until after the priority filing date of the present application, it is clear that the Olarig et al. reference does not qualify as prior art under 35 U.S.C. § 102(e)/103(c). Similarly, both the Santeler et al. reference and the claimed invention were, at the time the invention was made, owned by the present assignee (Compaq Computer Corporation) or subject to an obligation of assignment to the present assignee. Since the Santeler et al. reference did not issue until after the filing date of the present application, it is clear that the Santeler et al. reference does not qualify as prior art under 35 U.S.C. § 102(e)/103(c).

Without the Olarig et al. and Santeler et al. references, all of the Examiner's rejections under 35 U.S.C. § 103 are moot, since it is clear that none of the art of record and available as prior art either alone or in combination, discloses or suggests all of the elements recited in the present claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 3-10 and 16-38.

Conclusion

In view of the remarks and amendments set forth above, Applicants believe the claims to be patentable over the art of record and respectfully request allowance of claims 1, 3-10 and 16-38. If the Examiner believes that a telephonic interview will help speed this application towards issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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